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OFFICE OF PETITIONS

In re Application of	:	
Raman et al.	:	
Application No.: 10/758689	:	DECISION ON
Filing or 371(c) Date: 01/15/2004	:	PETITION
Attorney Docket Number: 1864.004US1	:	

This is a decision in response to the "Renewed Petition Under 37 CFR 1.181 to Withdraw Holding of Abandonment," filed February 7, 2008.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action. Mailed November 3, 2006. The Notices set a three (3) month period for reply. No reply having been received, the application became abandoned February 4, 2007, A Notice of Abandonment was mailed May 18, 2007.

November 9, 2007 Petition under 37 CFR 1.181

Applicant files the present petition and requests withdrawal of the holding of abandonment because the "Notice, mailed March 11, 2006 was not received." Applicant states that a search of the file jacket and docket records indicates that the Office communication was not received. Applicant also files a copy of the docket record where the non-received Office [communication] would have been entered had it been received.

December 14, 2007 Decision dismissing petition

A Decision dismissing the petition was mailed December 14, 2007. The Decision noted that a review of Office records revealed that the Office action, mailed November 3, 2006 was mailed to a correspondence address of record. Office records further revealed that the Office action was returned as undeliverable to this Office by the United States Post Office on November 6, 2006.

Finally, Office records revealed that a Change of Correspondence Address was filed on July 13, 2007.

In view of the above, it was unclear as to exactly when the correspondence address change was effectuated, and as such, there existed circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail.

The petition was dismissed without prejudice. Applicant was advised to file a request for reconsideration of petition and include a statement as to when the correspondence address change was effectuated.

The present renewed petition

Applicant files the present renewed petition and includes a statement that a search of the file jacket and docket records indicates that the Office action was not received. Applicant also includes copies of the docket record.

Applicant has not provided any information as to when the change of address actually occurred.

Applicable Law, Rules and MPEP

The MPEP 711.03(c)A, Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action, provides

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner **>describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

MPEP 711.03(c)

Analysis

As stated above, Office records reveal that the Office action, mailed November 3, 2006 was mailed to a correspondence address of record. Office records further reveal that the Office action was returned as undeliverable to this Office by the United States Post Office (USPS) on November 6, 2006. Office records also reveal that a Notice of Abandonment was mailed on May 18, 2007, and was also returned as undeliverable by the USPS on May 29, 2007. Thereafter, Applicant filed a Change of Correspondence Address on July 13, 2007.

In view of the fact that both the Office action and the Notice of Abandonment were returned as undeliverable by the USPS, and thereafter Applicant filed a change of correspondence, there are circumstances that point to a conclusion that nonreceipt of the Office action was due to Applicant's failure to timely file a change of correspondence address as required by 37 CFR 11.11.

Where an attorney or agent of record (or applicant, if he or she is prosecuting the application pro se) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP Code). See 37 CFR 11.11.

In this instance, Applicant has failed to state that the Office action was not received at the correspondence address of record. Moreover, Applicant has failed to state, as requested in the Decision dismissing the November 9, 2007 petition, when the correspondence address change was effectuated.

Applicant should file a renewed petition and state, over his registration number, when the address of Applicants changed. Applicant must demonstrate that the correspondence address was correct at the time the Office action was mailed.

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Therefore, it is extremely important that petitioner supply **any** and **all** relevant information and documentation with his request for reconsideration. The Director's decision will be based solely on the administrative record in existence.

Alternate venue

Applicant is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).


Further correspondence with respect to this matter should be addressed as follows:

By mail: Director for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
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Telephone inquiries concerning this petition Decision should be directed to the undersigned at (571) 272-3232.


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